



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,841	03/06/2002	Thomas J. Campana JR.	780.29643CX7	1530

20457 7590 03/15/2006

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-3873

EXAMINER

ESCALANTE, OVIDIO

ART UNIT PAPER NUMBER

2645

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/090,841	Applicant(s) CAMPANA ET AL.	
	Examiner Ovidio Escalante	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 86-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 86-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/6/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement submitted on March 6, 2002 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 86-94 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 86:

considering “[a] method of redirecting messages between a host system and a mobile data communication device.”:

it is not clear how the Applicant’s disclosure supports the “redirecting” feature. The Examiner’s interpretation of the “redirecting” limitation is that the message would have to first be directed to a destination and then after being directed to a destination the message can be directed to an alternative destination. However, upon reviewing Applicant’s disclosure, there does not appear to be any mentioning of “redirecting” the

message. The description provided by the Applicant in their claim diagram of the claims (response filed on March 6, 2002) appears to only support that the email is directed to a recipients wireless address if there is a match between the recipient's name and a name in the look up table stored in the email system.

The disclosure also appears to only state that the message sender only has to input a name e.g. "John Doe" and the processor will attempt to match the name with name in the look up table. However, the Examiner does not see how this is "redirecting" since the original message has not even been "directed" to a destination at that point. The claimed limitation specifically states "redirecting" between a host system and a mobile data communication device, the redirection of the e-mail must between the two systems.

considering "configuring one or more redirection events at the host system"

Applicant states in their claim diagram that the configuration of a redirection event is the designing of the email system to include the lookup table. However, the disclosure does not contemplate any "designing" feature rather the lookup table is already present in their disclosure and thus no designing employed. Therefore, it is not shown in Applicant's disclosure where "configuration of one or more redirection events" is supported.

considering "detecting that a redirection event has occurred at the host system and generating a redirection trigger":

Applicant's specification makes no mentioning of "redirection events", including the configuration and detection of the redirection events. Applicant has attempted to read this on disclosure of the lookup table; however, the lookup table in Applicant's disclosure

Art Unit: 2645

is only used for directing the original message from the sender to the recipient and not for redirecting. The Applicants have made the comment that the email system inherently generates a redirection trigger. However, since it has not been shown that “redirection trigger” is supported then, the email system cannot “inherently” generate a trigger.

considering “in response to the redirection trigger, continuously redirecting the messages from the host system to the mobile data communication device”:

The disclosure further appears to not support “continuously redirecting”. The support given by the Applicant states that “The storage of “John Doe” in the look up table before email message are received for “John Doe” will continuously cause all of “John Doe’s” email messages to be forwarded.” The Examiner cannot locate in the Applicant’s specification the support for a “redirection trigger” which will cause “continuous redirecting the messages.” It appears that for every new mail the Applicant’s disclosed invention will process the message according the look up table and thus all messages may not continuously go to the mobile communication device. That is, the message may go to both landline or wireless communication devices.

considering “receiving the messages at the host system and configuring address information of the messages such that the messages use the first address associated with the host system as the originating address wherein messages generated at either the host system or the mobile data communication device share the first address”:

The Examiner does not believe that there is support for configuring the first address associated with the host system as the origination address and that the generated messages share the first address. Applicants state that originated messages are processed

Art Unit: 2645

as conventional originated email messages and are forwarded to their destination address.

However, this does not support the use of configuring address information of the messages such that the messages use the first address associated with the host system as the originating address wherein messages generated at either the host system or the mobile data communication device share the first address.

Regarding claims 87-94, since the claims similarly recite the “redirection” limitation as well as other similar limitation, the claims are rejected for substantially the same reasons as set forth above.

If Applicant is to maintain that their original disclosure fully supports the claims, the Examiner respectfully asks Applicant to fully explain the “redirecting” language as well as fully state where each limitation as argued above is supported by citing specific page and line number citations for each limitation in all claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 86-94 are rejected under 35 U.S.C. 102(e) as being anticipated by Lazaridis US Patent 6,219,694.

Art Unit: 2645

Since it appears that Applicant's claims recite substantial new matter in regards to "redirection" event, triggers and other limitations as noted above, then the effective date for priority is the date of this instant Application.

Thus claims 86-94 are anticipated by Lazaridis from which Applicant has copied the claims. See claims 1,22-25,28-29,32-33.

Conclusion

6. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7537, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays.

Art Unit: 2645

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OVIDIO ESCALANTE
PATENT EXAMINER

Ovidio Escalante

Ovidio Escalante
Primary Patent Examiner
Group 2645
March 10, 2006

O.E./oe